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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHOW, CHIH CHING

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,352

Applicant(s)

MASUDA ET AL.

Examiner

Chih-Ching Chow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. Japan 2000-115239.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the application filed on January 03, 2005.
2. Claims 1-12 have been examined.

Response to Amendment

3. Applicants' amendment dated 01/03/2005, responding to the 08/03/2004 Office action provided in the objection of specification. The examiner has reviewed the updated specification respectfully. However, there still are points that are not unclear, such as the following:

- In the amendment of paragraph 12, "this characteristic or feature point may be a reserve word and/or a syntax pattern of macro instruction in a document file." However, in amended claim 1 recites, "extracting a feature point of a data file after having analyzed the data file", is the feature point in a 'data file' or in a 'document file'? If the 'data file' is the same as the 'document file', why use different names?
- In paragraph 13, the applicant amended the "depending the application program, one version of the application program may use different rules for instructing a computer (or other processing devices) to perform specific tasks in comparison to another version of the application program. Accordingly, most application programs define their own syntactical rules that control which words and/or instructions the computer understands." -- this sentence indicates that the feature points depend on a version of the application program, while the third sentence recited, "A version of the most suitable application program to open a document file becomes clear by

extracting these reserved words and/or syntax patterns." - this sentence implies that the version depends on feature points (feature points are reserve words and syntax patterns, according to paragraph 12), which contradicts to what is recited in the first sentence.

4. Applicants' amendment dated 01/03/2005, responding to the 08/03/2004 Office action for claim 8 under 35 USC § 112 (2) rejections The examiner has reviewed the updated claim 8, since claim 8 has been amended. Claim 8 currently reads as following: "The activation method mentioned in claim 3, further comprising: eliminating an existing file if insufficient space exists when the application program is executed"; it is still not clear if it means to eliminate an existing file when installing the application program or when executing the application program. Claim 3 has never mentioned 'activation method' (assuming that activation means execution) of the application program; the preamble of the Claim 8 is not valid. Therefore the rejection of claim 8 under 35 USC § 112 (2) remains.

5. Applicants' amendment dated 01/03/2005, responding to the 08/03/2004 Office action provided in the rejection of claims 1-12 under 35 USC § 103, wherein claims 1, 4, 8-12 have been amended. Applicant's arguments for Claims 1-12 have been fully considered respectfully by the examiner but they are not persuasive.

- For Claim 1, the Applicant's argument of Donohue's disclosure, last sentence of 'REJECTIN UNDER 35 USC § 103(a)', "This means that Donohue is limited to distributing software updates based on a predefined update criteria by conducting a search of available product updates using product

identifiers and release numbers" is not correct. Donohue searches all possible available updated software first then 'compare with update criteria', see Donohue Fig. 4A. Therefore, functionally, Donohue also 'analyze a data file (*compare the list with a predefined update criteria*) to determine or extract a feature point for selecting a version of an application program', also see Donohue's paragraph 28, "This comparison determines possible growth paths from the current to updated versions, but these possible growth paths are then compared 260 with predefined update criteria, and any possible paths which do not satisfy the update criteria are discarded." - The 'predefined update criteria' can be a special feature point as described in the current application.

- Claims 4, it's not clear since there is no explanation in the specification about 'at least two data files'.
- Claims 9 -12 rejections remain since Donohue's 'predefined update criteria' could include the 'feature point(s)' as recited above.

6. Applicants' amendment dated 01/03/2005, responding to the 08/03/2004 Office action provided in the rejection of for claims 1-12 rejections are maintained.

7. A summary of the rejections with the current amendment are listed as following:

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 5 recites "The activation method mentioned in claim 4, wherein: the readable data file is displayed with a different symbol figure by each version corresponding to the application program." - what is a 'different symbol figure' looks like? Is it displayable in regular PC? It's not explained in the specification. The examiner assumes they are set of characters, which is readable by the user.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: for "extracting a feature point of a data file after having analyzed the data file", where is the data file coming from and how does the extracting done? In the paragraph 13 recites 'the application program to open a document file becomes clear by extracting these

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reserved words and /or syntax patterns', however, it's not clear how does the 'extracting these reserved words and/or syntax patterns' is done.

12. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: for "detecting the reserved word specific to each version", it's not clear how does the 'detecting these reserved word specific to each version' is done, and what does the detecting related to the 'macro instruction' recited in the first part of claim 2?

13. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: for "detecting the feature point is a syntax pattern or the macro instruction included in the data file" - does the feature point got extracted by executing the macro instruction?

14. Claim 8 is rejected under 35 USC § 112, second paragraph, Claim 8 recites the limitation "The activation method mentioned in claim 3". There is insufficient antecedent basis for this limitation in the claim; see item 4 above.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-3, 8, 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6199204 by Donohue.

CLAIMS

1. An installation method of an application program comprising:
(a) extracting a feature point of a data file after having analyzed the data file,

(b) selecting a version of the application program suited for the data file based on the extracted feature point,

Donohue

Donohue teaches a method for automatically installing computer programs. For item a, in Donohue's invention column 8, line 32-35, "Assuming that software vendors provide via their Web sites a list 60 of available product updates referenced by **product identifier and release number 110** (or some other consistent naming convention is used)"; the 'extracting' is done in Donohue, see column 4, lines 14-21, "compares the available relevant updates with **update criteria held on the local computer system** (these update criteria are predefined for the current system or system user), and then automatically downloads and applies software updates which satisfy the predefined criteria." - the predefined criteria needs to be extracted in order to be compared; the "release number" is the same as the "version of an application" (item (b)). On Donohue's Fig. 2, the table shows the software product identifier along with the associated version number. Therefore, once a 'feature point' is identified

(extracted) the version number can be determined (claim 1 (a), (b)).

(c) judging whether the application program of a decided version is already installed; and

Donohue column 8, line 65-67 shows "a comparison 250 between the current installed software product's identifier and release number and the listed available updates in the retrieved file 160. This comparison determines possible growth paths from the current to updated versions... Thus, the updater component determines whether the available new versions and whether it is possible to apply patches to the current version..." The comparison is judging whether an application should be installed (claim 1 (c)).

(d) installing the application program of the version when the decided version of the application program is not installed.

Assuming this means install the application program if it's not currently installed yet (see rejection on 112 2nd paragraph for claim 1 (d)). Donohue teaches the feature extracting and version comparison, but does not install the software unless the software meets the 'predefined update criteria'.

8. The activation method mentioned in claim 3, further comprising: eliminating an existing file if insufficient space exist when the application program is executed.

See 112 (2nd) rejection above, claim 3 does not mention an 'activation method'. It's a common sense for any program execution, if insufficient space occurred, the computer would put out a warning for the user, the user would eliminating existing file in order to restore more space in the computer.

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11. An apparatus for installing an application program, comprising:

See claim 1 rejection.

(a) an extracting unit extracting at least one of a plurality of feature points of a data file after having analyzed the data file;

(b) a selecting unit selecting a version of the application program suited for the analyzed data file based on an extracted feature point;

(c) a judging unit judging whether the application program of a decided version is already installed; and

(d) an installation unit installing the application program of the version when the decided version of the application program is not installed.

12. A storage medium storing an application program, which when executed by a computer, sequentially executing:

The program is executing the updates has to be stored somewhere in the system in order to be executed. For item (a), see the rejection of claim 1 (a).

(a) extracting at least one of a plurality of feature points of a data file after having analyzed the data file;

(b) selecting a version of the application program suited for the analyzed data file based on an extracted feature point;

See the rejection of claim 1(b).

(c) judging whether the application program of a decided version is already installed; and

See the rejection of claim 1 (c).

(d) installing the application program of the version when the decided version of the application program is not installed.

See the rejection of claim 1(d).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4, 5-7, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6199204 by Donohue, as applied to claims above, in view of U.S. Patent No. 6282712 by Davis et al (herein after Davis).

CLAIMS

4. An activation method of an application comprising:
- (a) extracting at least one of a plurality of feature points of at least two data files after having analyzed the data files;
 - (b) selecting a version of the application program in which a data file is readable based on at least one of the feature points;
 - (c) displaying simultaneously the readable data file and the application program of a version decided thereby; and

Donohue / Davis

In Donohue, column 7, lines 62, Each vendor is assumed here to make available via their Web Sites such a list 60 of software updates (an example of which is shown in Fig. 2). Fig. 2 shows software updates list and retrieved software list; both the data file and the application program are displayed in web site for the user to access. Therefore it covers item (c). Donohue teaches the means of 'retrieving' (*activating*) the application program. In Donohue's claim 1, 3rd and 4th items, "means for initiating retrieval of software update resources which satisfy said predefined criteria; and means for applying a software update to one of the installed computer programs using the one or more

(d) activating the displayed application program in relation to any one of the analyzed data files.

retrieved software resources." But Donohue doesn't specifically allow the user to select certain application program, item (d). However Davis shows the feature to allow the user to manually select an application program in an analogous art for the purpose of ensure that the application program installation is necessary and appropriate (implied from Davis BACKGROUND OF THE INVENTION). In Davis' claim 1, 4th and 5th items, "selecting an edition of the software....", "automatically installing the **selected edition** of the software onto the new computer ...". It would have been obvious to a person of the ordinary skill in the art at the time of the invention to modify Donohue's updating software application disclosure with the user selection feature taught by Davis for the purpose of facilitating the installation of software within their distributed system (See Davis BACKGROUND OF THE INVENTION).

5. The activation method mentioned in claim 4, wherein: the readable data file is displayed with a different symbol figure by each version corresponding to the application program.

For the features of claim 4 see Donohue and Davis. Davis' disclosures display user readable 'symbol figure' for user to select. See claim 4 rejection.

6. The activation method mentioned in claim 4, wherein: only the readable data

Same as claim 4 rejection.

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file corresponding to a version of the application program is displayed when the application program is selected.

7. The activation method in claim 4, wherein: the installation of a corresponding application program is executed when an application program corresponding to the data file does not exist.

Same as claim 4 rejection.

9. A computer-readable medium on which an application program is recorded, the application program when executed by the computer, causes the computer to execute the functions comprising:

In Donohue's claim 1, "A computer program product, comprising computer program code recorded on a computer readable **recording medium**, ..." Here Donohue teaches us a record medium for a software update system. For claim 9 (a) see the rejection of claim 4 (a).

(a) extracting at least one of a plurality of feature points of at least two data files after having analyzed the data files;

(b) selecting a version of the application program which can read the readable data file based on at least one of the feature points;

See the rejection of claim 4 (b).

(c) displaying simultaneously the readable data file and the application program of a version decided thereby; and

See the rejection of claim 4 (c).

(d) activating the displayed application program in relation to any one of the analyzed data files.

See the rejection of claim 4 (d).

10. An apparatus for executing an application program, comprising:

See the rejection of claim 4 (a).

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(a) an extracting unit extracting at least one of a plurality of feature points of at least two data files after having analyzed the data files;

See the rejection of claim 4 (b).

(b) a selecting unit selecting a version of the application program which can read the readable data files based on at least one of the feature points;

See the rejection of claim 4 (c).

(c) a displaying unit simultaneously displaying the readable data file and the application program of a version decided thereby; and

See the rejection of claim 4 (d).

(d) an activating unit activating the displayed application program in relation to any one of the analyzed data files.

Allowable Subject Matter

19. Claims 2-3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claims 2 and 3 would be allowed if the applicant can clarify the 'feature point' is not the same as Donohue's 'predefined criteria', the way extracting feature point is different from the way Donohue's downloading predefined criteria, and explain how does the 'detecting' the feature point specific to each version work.

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Conclusion

The following summarizes the status of the claims:

35 USC § 112 (1st) paragraph rejection: Claims 5

35 USC § 112 (2nd) paragraph rejection: Claims 1-3, 8

35 USC § 102 rejection: Claims 1, 8, 11-12

35 USC § 103 rejection: Claims 4, 5-7, 9-10

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Ching Chow whose telephone number is 571-272-3693. The examiner can normally be reached on 7:00am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. For inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: 571-272-2100.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Ching Chow

Examiner

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C.C., 

ANTHONY NGUYEN-BA
PRIMARY EXAMINER